

REMARKS/ARGUMENTS

Information Disclosure Statement

An Information Disclosure Statement was submitted under separate cover on February 22, 2005, four days after the submission of the previous response by the Applicant, and eleven days prior to the mailing of the present Office Action as indicated in the attached copy of the postcard. It is believed that this information disclosure statement was timely submitted before the first Office Action in this continued examination. A copy of the Information Disclosure Statement is attached herewith for the Examiner's convenience.

Claim Rejection 35 U.S.C. §112

Claims 41 and 43 through 52 have been rejected because the limitation "chemical screening kit" is not found in the specification, and/or the term "kit" or description of a kit is not present in the specification that would allow one of ordinary skill in the art to recognize its structure.

The word "kit" and the phrase "chemical screening kit" need not be found in the specification to be used in the claims. As noted in MPEP 2163.02, second to last paragraph.

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

A kit claim is expressly recognized in *In re Venezia*, a case previously cited to the Examiner and acknowledged in the MPEP at 2173.05(g). In the *Venezia* case, issued as U.S. Patent 4,099,021, the word "kit" was not used in the specification, but only in the claims. It is therefore well established that the word "kit" or similar phrase need not be found in the specification.

Accordingly, the Examiner's rejection must be based not on the fact that chemical screening kit is not found in the specification or that the term "kit" is not found in the specification, but that the description would not lead someone of ordinary

skill in the art to recognize that a kit has been described. A dictionary definition of "kit" is a "set of parts to be assembled". Looking at the specification, it is clear that a kit has been described. At page 4, lines 8-12, the application indicates:

Multiple strips may be processed in parallel to obtain the benefit of efficient production of a large number of the strips. Yet, the strips are easily handled and identified and may be assembled into dense planar arrays with desired arbitrary row variations. By using strips, an improved tradeoff between mass production and flexibility is obtained. (page 4, lines 8 through 12).

One of ordinary skill in the art would recognize that the mass produced strips are a kit because they are "a set of parts" to be assembled into planar arrays of arbitrary row variations.

The specification further says at page 4, lines 22-25,

Thus it is one object of the invention to facilitate the screening of chemical compounds against a large number of sample compounds in an efficient yet flexible way. Each strip may manufactured in a batch including many other strips and, then separated from the batch and assembled to produce a variety of different arrays.

A person of ordinary skill in the art would recognize this language to be describing a kit or a set of parts in the form of strips that are assembled to produce a variety of different arrays.

Page 10, lines 7 through 17 of the specification describes:

Referring now to Fig. 4, it will be understood that the technique of assembling short lengths of the filaments 10 into an array 32 allows a wide variety of semi-custom arrays 32 to be created from a more limited set of standard filaments 10. In Fig. 4, the letters indicate different sampling compounds 14. The sequence of sampling compounds 14 of each row formed by a filament 10 will be defined by the set of standard filaments 10. Nevertheless, the number of different arrays 32 will be equal to the mathematical combination of the number of different filament types, a far larger number. For example, from a library of 400 standard fibers, 10^{119} different 200 fiber arrays 32 may be created. In this way, the use of filaments 10 to create an array 32, leverages a limited number of filament types into an extremely flexible variety of arrays 32. The arrays 32 may be assembled efficiently by robotic techniques or the like and may be verified by reading the identification markers 24 unique to each filament."

It is very clear that the library of 400 standard fibers represents a set of parts that may be assembled.

It is possible that the Examiner is reading into the word "kit" a limitation that requires that the assemblage of parts be received by the ultimate consumer as a kit. However, the Applicant intends no such limitation, but rather that the claims represent a kit used either by the consumer to generate custom arrays or by the manufacturer to produce custom arrays for the consumer.

Claim Rejection 35 U.S.C. 103

A rejection of claims 41, 43, 45 through 46 and 48 as being unpatentable over Gross in view of Zuk is respectfully traversed. The Examiner suggests that Gross teaches all of the elements of the instant claims except that it is silent with respect to them being in a kit form. This is facially incorrect as has been previously noted. Nor has the Examiner addressed any of the specific deficiencies in the art listed in the previous response.

Gross teaches the use of paper strips each having identical linear arrays of chemically reactive substances as opposed to strips with "different arrays of chemically reactive substances" required of claim 41. The paper strips of Gross are individually exposed to different urine samples as opposed to the "mutual exposure [of the strips] to a material to be screened" required by claim 41. The frame of Gross is only used for photometric (light) analysis. Gross does not teach a "library" of different strips and the placing of a "subset of the library of strips" into the frame because all the strips of Gross are the same so there is not meaningful library/subset relationship.

Thus Gross fails to teach multiple elements of the present invention other than the fact that it is a kit. These failures of Gross are not remedied by Zuk.

Zuk teaches kits for preparing liquid reagents. Accordingly, Zuk does not remedy the deficiencies of Gross because Zuk also does not teach strips with "different arrays of chemically reactive substances" required of claim 41. Nor does Zuk teach "mutual exposure [of the strips] to a material to be screened" required by claim 41.

Finally, Zuk does not teach a "library" of different strips and the placing of a "subset of the library of strips". Accordingly even the combination of Gross and Zuk, assuming such a combination were proper, would not meet the limitations of claim 41.

In light of these remarks and comments, it is believed that claims 2, 5 through 7, 9 through 13 and 35 as previously allowed, and 41, and 43 through 52 are now in condition for allowance and allowance is respectfully requested.

Although no additional fees are believed due for filing this amendment, if an additional fee is deemed to be due, please charge any fee to Deposit Account No. 17-0055.

Respectfully submitted,

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Keith M. Baxter, Attorney of Record

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): David C. Schwartz
Serial No.: 09/638,102
Filed: August 11, 2000
For: Chemical Screening Using Strip Arrays
Art Unit: 1641
Docket No.: 960296.97133

INFORMATION DISCLOSURE STATEMENT

The following are submitted in the above-identified application in compliance with 37 CFR 1.97 & 1.98:

- ☒ A list of documents on Form PTO-1449 together with copies of each identified document, (if required);
- ☐ A translation or a concise explanation of each non-English language document is enclosed herewith.

This paper is submitted in accordance with:

- ☒ 37 CFR 1.97(b) (within 3 months of filing or prior to mailing of 1st Office Action)
- ☐ 37 CFR 1.97(c) (before Final Office Action or Notice of Allowance); and
 - ☐ The required certification made under the heading "Certification" below;
 - or
 - ☐ The \$_____ fees specified in 37 CFR §1.17(p) for submission of this Information Disclosure Statement is authorized under the heading "Authorization to Charge Fees" below.

☐ 37 CFR 1.97(d) (before issue fee payment); and

a) This is a petition for consideration of the subject Information Disclosure Statement. The petition fee \$ _____ required by 37 CFR 1.17(i)(1) is authorized under the heading "Authorization to Charge Fees". (Direct this letter to "Attention Petitions Examiner" and if applicable include batch locator information: e.g. "Allowed Files, Batch _____, Date of Allowance _____"), and

b) The required Certification is stated under the heading "Certification" below.

☐ Certification

☐ Each item of information contained in this Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement; or

☐ No item of information contained in this Statement was first cited in any communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing this document after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than three (3) months prior to the filing of this Statement.

☒ Authorization to Charge Fees

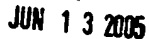
Please charge all applicable fees associated with the submittal of this Information Disclosure Statement to Deposit Account No. 17-0055.

Respectfully submitted,

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| Application Number | 09/638,102 |
| Filing Date | August 11, 2000 |
| First Named Inventor | David C. Schwartz |
| Art Unit | 1641 |
| Examiner Name | Deborah A. Davis |
| Attorney Docket Number | 960296.97133 |

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| FOREIGN PATENT DOCUMENTS | | | | | | |
|--------------------------|-----------------------|---|--------------------------------|---|---|----------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear | T ⁶ |
| | | Country Code ³ ~Number ⁴ ~Kind Code ⁵ (if known) | | | | |
| | 1 | EP 0 385 433 | 09-05-1990 | Ceskoslovenska Akademie | | |
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| | | Application Number | 09/638,102 |
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| | | First Named Inventor | David C. Schwartz |
| | | Art Unit | 1641 |
| | | Examiner Name | Deborah A. Davis |
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| | 2 | BROWNE et al., "Intrinsic Sol-Gel Clad Fiber-Optic Sensors with Time-Resolved Detection", Analytical Chemistry, July 15, 1996, pp 2289-2295, Vol. 68, No. 14, | |
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